

REMARKS

The above-referenced patent application has been reviewed in light of the Final Office Action, dated August 1st, 2001, and the Advisory Action, dated Oct. 24th, 2001, in which: Claims 1, 3-7, 11-17, 19-27 and 29 are rejected under 35 U.S.C. 103(a), as being unpatentable over a combination of Fan (U.S. Patent No. 5,359,676, hereinafter "Fan") and Go (U.S. Patent No. 5,878,172, hereinafter "Go"); Claims 8-10, 18, and 28 are rejected under 35 U.S.C 103(a) as being unpatentable over Fan and Go, as applied to claims 6, 17, and 27, and further in view of Chamzas et al. (U.S. Patent No. 4,870,497, hereinafter "Chamzas"). Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1 and 3-29 are now pending the above-referenced patent application. Claim 1 has been amended, no claims have been deleted or added.

It is noted that the Applicant made an error in the previous amendment, which was noted by the Examiner in the Advisory Action. Applicant inadvertently stated "There is no contemplation of preprocessing an image or to transmitting an image in Go, and Go appears to relate to interpreting a decoded image, rather than disassembling and reassembling an image as expressed in Fan." Applicant meant to say, instead, that there is no contemplation of preprocessing an image or to transmitting an image in Fan, and Fan appears to relate to interpreting a decoded image, rather than disassembling and reassembling an image as expressed in Go. Applicant regrets any inconvenience this may have caused.

As stated in the previous response, even if there was a suggestion or motivation to combine Fan and Go, there still would be elements of the claimed subject matter not met by the combination. It is well established that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the Examiner must show a suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify a prior art reference or combine two or more prior art references. Second, the Examiner must show a reasonable expectation of success in making this combination or modification. Third, the Examiner must show that the combination or modification, if proper, contains all of the elements of the application under

examination. If any of these elements are not met, the Examiner has failed to establish a successful *prima facie* case of obviousness. The example given in the previous response referenced the edge detection methods disclosed by Fan and Go, as compared to the claimed subject matter. Go discloses a sum of differences approach, as stated on col. 6, line 66, to col. 7, line 23. This method disclosed by Go is applied to both the horizontal and vertical directions individually. Conversely, the detailed description of the present application, page 7, line 14 to page 8, line 15, discloses multiple methods for edge detection that may be used in accordance with the claimed subject matter, none of which employ the approach of Go. It is respectfully asserted that Fan and Go disclose different solutions to a similar problem, and the differences are patentably distinct.

Specifically, there is no contemplation in either Fan or Go to transmit image data and edge detection data separately, or to compress or code image data and edge detection data separately. It is conceded by the Examiner that the combination of Fan and Go discloses a method of transmission where the image data and edge detection data is multiplexed prior to transmission. Quoting from Go, column 6, lines 9-14, "The multiplexer 26 combines the reduced image information Cr and edge image information Cs into an encoded image C, which is output to a first input/output device 28 ..."

Conversely, quoting from the present application, page 10, lines 6-12, "Although the invention is not limited in this respect, it is envisioned that an edge detection map may be transmitted as supplemental signal information corresponding to a coded video frame. Therefore, at the far or receiving end of the communications channel, depending on the capabilities of the decoder, this edge detection map may or may not be employed to enhance the decoded video frame, as described in more detail in the embodiment below. Likewise, in addition to transmitting one edge detection map, in alternative embodiments, multiple edge detection maps may be transmitted, as previously indicated." **As can be seen from these excerpts, there is no contemplation in the cited patents to compressing or transmitting edge image information separately from image information, and therefore, an element of the claimed subject matter is not present in the cited patents. Therefore, the Examiner has failed to meet at least one prong of the three-prong test for obviousness.**

According to the Examiner, "[A]pplicant does not offer any specific arguments or reasoning as to why the references cannot be combined. Nor is any reason given as to why one of ordinary skill in the art would not have found suggestion or motivation to combine the references as presented by the Examiner."

Contrary to the Examiner's opinion, Applicants have presented specific reasons why there is no suggestion or motivation to combine these two references. Quoting from Applicants' response to the Final Office Action, "Fan relates to a method for improving the appearance of a decoded image by using various local post processing techniques. There is no contemplation of preprocessing an image or to transmitting an image in Go, and Go appears to relate to interpreting a decoded image, rather than disassembling and reassembling an image as expressed in Fan. There does not appear to be any teaching or suggestion found within Fan or Go to combine these two references."

Regardless, it is well-established that the Examiner has the burden to show a suggestion or motivation why two or more references can or should be combined, rather than an applicant having the burden to show why they cannot or should not be combined. It is additionally well-established that the mere fact that references can be combined does not render the resultant combination obvious. It is respectfully asserted that the Examiner has failed to meet the burden for showing a suggestion or motivation to combine. Therefore, the Examiner has failed to make a *prima facie* case of obviousness, and it is respectfully asserted that the claims 1, 3-7, 11-17, 19-27 and 29, as amended, are in a condition for allowance.

According to the Examiner, *Chamzas* is analogous art. Applicants respectfully disagree with this position. It is well-established that a reference must be analogous prior art in order to properly be used in a rejection under 35 U.S.C 103. As stated in MPEP 2141.01(a), and as quoted in *In Re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." It is respectfully asserted that the *Chamzas* reference does not appear to be reasonably pertinent to the particular problem solved by the present application, nor is it within the specific field of endeavor. The

mere fact that the *Chamzas* patent and the rejected claims both involve image data transmission is by itself not sufficient to make them analogous. As established in *Wang Labs v. Toshiba*, 26 USPQ2d 1767 (Fed. Cir. 1993), where the patent claims were directed to a single in line memory module (SIMM), reference to an industrial controller SIMM was not necessarily in the same field of endeavor merely because it also dealt with memories or SIMMs. The reference was found to be in a different field of endeavor because it involved circuits in which modules of varying sizes could be added or replaced, whereas the claimed invention involved compact modular memories. Therefore, using reasoning derived from *Wang*, even if a cited reference is based in the same technological arena, it does not automatically become analogous.

The Examiner concedes that the field of endeavor for the *Chamzas* patent is progressive transmission of two-tone images, and states that the field of endeavor of the rejected claims are encoding and decoding of video frames. While not necessarily agreeing with the Examiner's characterization of the rejected claims, it is clear that the *Chamzas* patent is not within the field of endeavor. It is, therefore, respectfully asserted that claims 8-10, 18 and 28 are in a condition for allowance.

The test for reasonable pertinence was established in *In Re Clay*, 23USPQ2d 1058 (Fed. Cir. 1992), where the court determined that "A reference is reasonably pertinent if, even though it may be in a different field from the inventors endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering this problem." It is respectfully asserted that the *Chamzas* patent is not "reasonably pertinent" and one skilled in the art would not be motivated to consider such a reference in seeking a solution to a problem such as one of the problems solved by the claimed subject matter.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-9427. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



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Dated:

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The following claims have been amended as follows:

1. (Twice Amended) A video processor system comprising:

a video coder, the video coder including the capability to generate an edge detection map along a predetermined direction for an uncoded frame that is to be coded, wherein said video coder includes the capability to compress the edge detection map, wherein said video coder includes the capability to compress the edge detection map separately from said frame that is to be coded.